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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,610	09/15/2003	Bret R. Marschand	29617/PM482	3529

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EXAMINER

DEVORE, PETER T

ART UNIT PAPER NUMBER

3751

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/663,610	Applicant(s) MARSCHAND, BRET R.	
	Examiner Peter T deVore	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/23/2003</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 7, 9-12, and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Guu.

The Guu reference discloses a writing instrument comprising a tubular body 10, a writing tip 20, a receptacle (at end of body 10 opposite tip 20), removable auxiliary module 36, and auxiliary module cap engageable on either end (see Figure 1) and inherently usable as a data entry tip for a PDA. Regarding claims 7, 9, and 14-17, note that pen nib 20 can also be considered the auxiliary module and in that case pencil 30 is considered a writing tip. Regarding claim 18, the claimed method is inherently performed during the normal use of the Guu writing instrument.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guu in view of Christopher.

The Guu reference discloses a writing instrument as discussed supra, but does not disclose that the writing tip is retractable. However, attention is directed to the Christopher reference, which discloses a similar writing instrument wherein the tip is retractable for convenient storage of the tip (see abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the writing tip of the Guu device retractable in view of the teachings of Christopher for convenient storage of the tip.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guu in view of Harris.

The Guu reference discloses a writing instrument as discussed supra, but does not disclose that the module is engageable with the receptacle via a projection engaging an L-shaped track. Instead, the module is interference fit with the receptacle. However, attention is directed to the Harris reference, which discloses a similar writing instrument wherein module is engageable with the receptacle via a projection engaging an L-shaped track (see Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the module of the Guu device engageable with the receptacle via a projection engaging an L-shaped track in view of the teachings of wherein so doing would amount to mere substitution of one functionally equivalent module/receptacle engagement for another within the same art and the

selection of any of these module/receptacle engagements would work equally well in the Guu device.

Claims 5, 6, 8, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guu in view of Holmes.

The Guu reference discloses a writing instrument as discussed supra, but does not disclose that the auxiliary module dispenses correction tape. However, attention is directed to the Holmes reference, which discloses a similar writing instrument wherein the auxiliary module includes a tape dispensing reel 18, a take-up reel 8, and a differential belt 6 which together act to dispense correction tape for convenient correction of errors in the writing process. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the auxiliary module of the Guu writing instrument to include a tape dispensing reel, a take-up reel, and a differential belt which together act to dispense correction tape in view of the teachings of Holmes for convenient correction of errors in the writing process. Regarding claim 19, the claimed method is inherently performed during the normal use of the modified Guu writing instrument.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter T deVore whose telephone number is (703) 306-5481. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (703) 308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pd Pd

A handwritten signature in black ink, appearing to read 'Gregory L. Huson', is written over a horizontal line.

GREGORY L. HUSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700